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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/612,239
Filing Date: July 01, 2003
Appellant(s): KUO, ERIC

Michael T. Rosato
TOWNSEND and TOWNSEND and CREW LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 13, 2007 appealing from the Office action mailed February 13, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 45 and 46 under 35 U.S.C. 112, first paragraph, is withdrawn in view of appellant's remarks. These claims still remain part of this appeal because they are also rejected under 35 U.S.C. 103(a).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,975,893	CHISHTI ET AL.	11-1999
4,038,753	KLEIN	8-1977
2003/0136698	KLATT	7-2003
6,206,695	WONG ET AL	3-2001
5,326,259	ROHLCKE ET AL	7-1994
6,884,071	MARTIN	4-2005
5,923,001	MORRIS ET AL	7-1999
5,411,295	BATES ET AL	5-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-21 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klein (4038753). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the appliances on a framework with non-numeric indicia. Klein teaches packaging dental appliances 18 by providing them on a framework 16 and using non-numeric indicia, "REG" see Fig. 1. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing packages on a framework and non-numeric indicia as shown by Klein in order to make use of known ways of solving the problem of

providing dental appliances. Chishti teaches indicating the order of use. To supply the appliances in the order of use on the frame would have been obvious to one of ordinary skill in the art to make it easy for a user to follow the desired order. All of the structure being shown, the specific meaning of the indicia, is merely a matter of mental interpretation, and/or, intended use, and as such, is properly not given patentable weight. As to claim 48, the above combination shows arranging on a framework, all of the structure being shown, the meaning of the arrangement is merely a mental step, and/or, intended use of the shown structure, and as such, is not given patentable weight. Further Chishti teaches ordering by use.

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klatt (2003/0136698). Chishti teaches providing packages of successive appliances having different geometries to move teeth and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the appliances in a package in order of use. Klatt teaches providing items in the form of distinct packages 5 in a larger package 1 in the order of use, [0006]. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing distinct items in a package in their order of use as shown by Klatt in order to make use of known ways of solving the problem of providing package articles and indicating the order of use. The terminology "geometrically distinct" is not defined by the disclosure, and as such, Klatt is held to show distinct packages that are geometrically located in

distinct locations as indicated. Chishti teaches ordering geometrically distinct appliances.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Rohlcke et al (5326259). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to use non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the art to modify Chishti to include the type of indicia shown by Wong in order to make use of known indicia to best communicate the desired order. The above combination does not show using a cutout notch. Rohlcke teaches that a notch may be used as an alternative indicia, column 1, lines 21-24. It would be obvious to one of ordinary skill in the art to modify the above combination to include a notch as shown by Rohlcke in order to make use of known alternative indicia.

Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Martin (6884071). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to use non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the art to modify Chishti to

include the type of indicia shown by Wong in order to make use of known indicia to best communicate the desired order. The above combination does not show using a bar code as indicia. Martin teaches that a bar code may be used as an alternative indicia, column 7, lines 24-27. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bar code as shown by Martin in order to make use of known alternative indicia.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Martin (6884071) as applied to claim 40 above, and further in view of Morris et al (5923001). The above combination does not show using a radio frequency tag. Morris shows using radio frequency tags to identify items. It would be obvious to one of ordinary skill in the art to modify the above combination to include a radio frequency tag as shown by Morris in order to make use of known ways of using and reading indicia to best communicate the desired message.

Claims 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to use non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the art to modify Chishti to include the type of indicia

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shown by Wong in order to make use of known indicia to best communicate the desired order. The type of color used is an obvious matter of choice in the type of indicia used to one of ordinary skill in the art. As to claim 47, Chishti teaches including the appliances in marked containers, column 15, lines 1-5. To call these containers wrappers is merely terminology.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) as applied to claim 44 above, and further in view of Bates et al (5411295). The above combination does not show using a water or air dissolvable dye. Bates teaches using a water dissolvable ink, column 4, line 62 through column 5, lines 1, for indicia. It would be obvious to one of ordinary skill in the art to modify the above combination to include a water dissolvable ink as shown by Bates to make use of known indicia materials. Ink obviously has color.

(10) Response to Argument

Claims 19-21 and 48:

Appellant argues that the combination of Chishti et al and Klein fail, at least, to teach non-numerical indicia designating an order of use as recited in claim 19, that while Chishti teaches numerical indicia for order of use, the reference does not teach any non-numeric indicia, and that, Klein fails to teach non-numeric indicia designating order of use because Klein does not teach non-numeric indicia because the reference teaches a combination of numeric and non-numeric, "A-1-REG", and because Klein

does not teach indicia for order of use because the indicia "A-1-REG" is for size, not order of use. Appellant further states that the term "A-1-REG" appears incapable of designating any order of use, and because all of the orthodontic rings of Klein are the same, order of use would seem completely irrelevant and that no reasonable mental interpretation of the term could designate order of use.

The examiner disagrees with this argument because the combination teaches using indicia for order of use, Chishti, and shows that it is known in the art to use non-numeric indicia, Klein. Klein is held to properly suggest to one of ordinary skill in the art, that non-numeric indicia can be used to convey information in the art. It is further held that the showing of a combination of numeric and non-numeric, "A-1-REG", of Klein does not obviate the teaching that non-numeric indicia can be used. The use of indicia to show order is properly taught by Chishti, it is not necessary for the secondary reference to show every claimed feature, instead, the reference merely has to suggest the combination to one of ordinary skill in the art. In this case, Klein suggests using non-numeric or numeric indicia. One of ordinary skill in the art would be expected to be able to substitute non-numeric indicia for numeric indicia and to be able to use such indicia to designate order of use in view of the teaching of the combination and level of skill of one in the art.

Claims 27-29:

Appellant argues that the combination of Chishti and Klatt fails to establish the element of a package including a plurality of geometrically distinct dental appliances positioned in an arrangement within the package which indicates an order of usage.

Appellant further argues that Chishti does not teach non-numeric indicia in the form of appliances arranged in a package designating order of use, and that Klatt shows identical stacked blister cards that have no particular ordering or stacking because they are identical. In view of the blister cards being identical, they do not meet the limitation of "geometrically distinct" appliances, and Klatt would only suggest randomly stacking the dental appliances of Chishti.

The examiner disagrees with this argument because Chishti teaches order of use and geometrically distinct appliances, while Klatt shows stacking packages in an inherent order of use and suggests in prior art that purpose for stacking, see [0004]. The combination is held to properly suggest the claim language to one of ordinary skill in the art.

Claims 38 and 39:

Appellant argues that Chishti does not show the elements as argued above and that Wong does not teach color handles to indicate order of usage of the orthodontic reamers, instead, the color is used to indicate size, and further argues, that the mere fact that they are used in progressively larger sizes for performing a root canal does not provide the teaching of using a color scheme as an indication for order of usage.

The examiner disagrees with this argument because Wong teaches the well known dental procedure of using files in order of size, see Abstract, and teaches using color to designate size. One of ordinary skill in the art would obviously recognize that color is used to designate order of use. Wong also teaches color and numbers are known equivalent indicators, column 3, lines 59-65.

Appellant argues that Rohlcke uses a notch to designate orientation, not order of use, and therefore, does not teach the claimed invention and that it is unclear regarding any rationale as to why one of ordinary skill would combine the references because there is no logical connection between the teachings of Rohlcke and Wong.

The examiner disagrees with this argument because Chishti teaches using indicia (numeric) to designate order of use of the appliances, Wong clearly teaches that a non-numeric indicia (color) is an equivalent indicia to numeric indicia as cited above, and suggests its use to one of ordinary skill in the art for designating order of use, and Rohlcke teaches that it is also known in the art that a notch is equivalent indicia to color, column 1, lines 21-24, and therefore, suggests the substitution of structural equivalents to the skilled artisan.

Claims 40 and 41:

Appellant argues Chishti and Wong as above, and further, argues that Martin uses bar codes for designating mixing time, the material and dates, as such, Martin does not teach designating order of use.

The examiner disagrees with this argument because Martin teaches that use of bar codes is a known equivalent to color, column 7, lines 24-27, for conveying information, and therefore, for the same reasons as given with respect to claims 38 and 39 above, the combination of Chishti and Wong with Martin would be obvious to one of ordinary skill in the art.

Claims 42 and 43:

Appellant argues that Morris fails to provide the teachings missing from Chishti, Wong and Martin, because it fails to teach radio frequency tags used to designate order of use.

The examiner disagrees with this argument because Morris teaches that it is known in the medical arts to use radio frequency tags for identifying indicia, and as such, the combination would have been suggested to one of ordinary skill in the art as a substitution of known information carrying indicia.

Claims 44 and 47:

Appellant repeats the argument made with respect to Chishti and Wong as applied to claims 38 and 39.

It is held that this combination is proper and obvious as stated above with respect to claims 38 and 39.

Claims 45 and 46:

Appellant refers to the arguments as related to Chishti and Wong above, and further argues that Bates does not provide a teaching of designating order of use.

It is held that Chishti teaches designating order of use, and that Bates is used in a combination providing an alternative indicia that one of ordinary skill in the art would find obvious to combine.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John J Wilson/

Primary Examiner, Art Unit 3732

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TQAS TC 3700